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| 10/713,446 | 11/14/2003 | Kenneth A. Walker JR. | 03-025 | 9623 |

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| EXAMINER |
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WOODS, ERIC V

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| ART UNIT | PAPER NUMBER |
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2672

DATE MAILED: 08/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|--------------------------------------|--------------------------------------|--|
| Office Action Summary | Application No. 10/713,446 | Applicant(s) WALKER ET AL. | |
| | Examiner Eric V. Woods | Art Unit 2672 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-11,13-17 and 21-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-11,13-17 and 21-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 June 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

Examiner accepts the drawings after amendments.

Specification

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Examiner accepts the specification after amendments.

Response to Arguments

Applicant's arguments, see Pages 1-3, filed 10 June 2005, with respect to the objections to the specification and to the drawings have been fully considered and are persuasive.

The objections to the drawings have been withdrawn in view of applicant's amendments.

The objections to the specifications have been withdrawn in view of applicant's amendments.

Applicant's arguments, see pages 1-3, filed 10 June 2005, with respect to the rejection(s) of claim(s) 1-20 under 35 U.S.C. 103 over various combinations of references have been fully considered and are persuasive. Therefore, the rejection has been withdrawn.

However, upon further consideration, a new ground(s) of rejection is made in view of various other references. Applicant's amendments sufficiently changed the metes and bounds as well as the scope of the instant claims that a final rejection using an entirely new set of references would be proper.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Roses and Noda in view of Blumberg (US 2005/0144256 A1, priority to March 11, 1999). Any dependent claims that have means plus functional language are covered by the rejection of such components in the rejection immediately below, so such language will not be explicitly addressed. Further, any rejections valid on claims 1-10 are equally valid on the corresponding claims of set 11-20. Claim 11 is directed to a system

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implementing the method of claim 1, and the means-plus-function limitations are discussed below.

As to claims 1 and 11,

A computer-implemented method for facilitating user customization of the image content of an image area in an electronic product design, (Roses [0068] stating the method is computer-implemented, Fig. 1 clearly shows a document composition website 110 that is connected to a customer photo web site 115 and general web site 120 for obtaining photos and images for obtaining image content for insertion into a document (see Fig. 2, where the images are put into an image basket) and such documents and their templates are shown in Fig. 5, with an image editing step shown in Fig. 6 with cropping capabilities as shown and in [0037,0043,0048], and Noda clearly allows the user to manipulate the image area for cropping as shown in Fig. 2 with the boundaries and crop frame 84)

-The method comprising displaying an electronic product design to a user, the design comprising at least one or more user-customizable image areas, each image area having displayed content that is at least a portion of a base image associated with the image area; (Roses shows an electronic document or product design in Fig. 5, with the image areas shown in Fig. 6 and allowing the user to manipulate them – see [0028] for posters, Fig. 10 shows as item 1021 and next to it, that a “Year 2001 Calendar Type” can be chosen as a template, thus illustrating another type of document template, the document creation module / tool of Roses is shown in Fig. 2 as element 206, which is facilitated by the document creation / storage module 306 in Fig. 3 – see [0032-0033],

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where Roses teaches that documents have areas for fixed images (e.g. images with a fixed size, thus requiring cropping as in Fig. 6). Further, in [0047], it is taught that templates can have modifiable images, e.g. images that can be modified by the user, wherein the fixed images consist of images of a given size for insertion into a block, where in [0048] it is taught that the fixed images are clearly modifiable, since they can be cropped, filter, moved (location), et cetera) (User selects the image as input in Noda [0052], and further Noda allows the user to select the inner area where the image will be inserted from a template [0002,0024], and in Figs. 9A-9F where various layouts of photos for albums, etc. are shown. Further, these areas exist and may have a base size [0077-0078], as is known in the art (e.g. L-size, etc.) However, the user can set the size of these areas to a certain extent [0082-0085] by modifying the crop boundaries within the image, and also within Figures 10A-10D various other templates are shown, where the user could for example change the positions of the components of the template)(Blumberg teaches that the use of scalable documents, e.g. the user is allowed to choose the resolution / size, and relative position of an image within a document, for example see the template in Figure 3, where the user requests the portion of an image that is desired [0101], and the selected portion of the image is displayed within the frame of the image in the document (see Figure 4))

-Allowing the user to select an image area for customization of the displayed content of the image area, and (Roses [0047-0048] wherein there are modifiable images in the template that the user can customize, and also the fixed images can be customized by allowing the user to choose the image)(User selects the image as input in Noda [0052],

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and further Noda allows the user to select the inner area where the image will be inserted from a template [0002,0024], and in Figs. 9A-9F where various layouts of photos for albums, etc. are shown, and finally in [0042-0043] it is taught that the user can select and customize the placement of text and images in modifiable areas)

-In response to user selection of an image area, displaying to the user

--The associated base image, and (Roses Fig. 6 and [0043-0044], where the image is displayed in the section 611 for example, and the user can preview the document so in area 602 whilst editing it here)(Noda Fig. 3 where the image is displayed in area 46, and the user selects which image to show [0052] in the full size)

-- A cropping indicator positioned to indicate to the user the position of the base image currently displayed in the image area. (Cropping indicator 84 in Noda Fig. 3 as discussed in [0081] is fit to the selected paper size or template spot)(Blumberg teaches that the user can select the desired portion ([0097-0105]) and that there is a link to the larger version of the image so that the user can see the desired portion and zoom in and out and the like, which results in only the desired portion of the image being shown as Figures 4A-4C).

Applicant invokes means-plus-function language in claim 11. Clearly, the recited means would be equivalent to that of applicant. For example, the customization capabilities of the Roses reference in Figs. 4-7 and as taught in [0042-0043], where templates can be edited and have specific areas and layouts, as does Noda, for example in Figs. 9A-9F, and even more so in Figs. 10A-10D where the user can configure the locations of the various regions that are superimposed, which clearly

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provides the functionality recited by applicant in the specification and shown in for example Fig. 3. In Fig. 4 of the instant application, where the user can change cropping of an image, the user clearly can make those choices as shown in Fig. 6 of Roses and Figs. 3-5 and 11-13 of Noda, and the user can switch between images as shown with the navigation buttons on the Roses reference in Fig. 3 in the image chooser box, and Noda also allows modification in that manner. Clearly the image modification system of applicant shown in Figs. 5-9 of the instant application corresponds to the system of Noda in Fig. 3, with the manipulable cropping areas and boundaries (see element 84) and further in [0081-0084] Noda reveals that the crop boundary may be changed in size so as to correspond to the capabilities of applicant's recited invention. Clearly, both systems are software, and it is well known in the art that any piece of software functionality can easily be implemented on another (same look and feel) in a manner where the functionality is alike yet uses completely different code to do so. As such, the means plus function limitations under 35 U.S.C. 112, sixth paragraph, have been met, and examiner has met the burden to prove a *prima facie* case of equivalence between the recited elements. It is now applicant's responsibility to rebut the premise that applicant's invention and the equivalent functions of Roses and Noda are the same if applicant wishes to do so.

Roses teaches all the limitations of the stated claims, but does not expressly provide for the cropping indicator having the same height-to-width ratio as the selected image area, although since the image can be cropped such that it fits in the template, this is implied. Reference Noda also teaches most of the limitations, and explicitly

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teaches the use of customizable images and templates, and a manipulable cropping tool. Obviously the references are directed to a similar problem solving area and are analogous art, as both deal with inserting images into document templates and manipulating them.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the system of Roses with that of Noda because the system of Noda clearly allows for more effective cropping of images to fit in templates as set forth in the paragraphs above, especially since Roses does not show how the images are cropped per se or if the user is able to expressly choose the desired portion of an image to go in the template, and further Noda allows more options as far as customizing images such that when the image customization process is complete, multiple images could be combined into one and put into the documents of Roses (Figs. 4-6) or Noda (Figs. 10A-10D), which would prima facie allow for greater flexibility in how the user can manipulate the documents, as shown in Noda, which is beneficial.

The present amended version of the claims takes the old limitations and adds some additional features, as noted in applicant's Remarks page 3. The Blumberg reference is brought in to cover that limitation. The Blumberg reference teaches a method of viewing scalable documents (abstract), where the document contains a reference to an image rather than the image itself, where the image resides on a remote image server. The image is displayed in a smaller version than the full-resolution version, and the system allows the user to see a certain portion of the older image (or the entire image) within a window of fixed size, such that the user can zoom in and out,

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and see different areas of the document at level of detail is desired (Blumberg [0093-0106]). The point of this reference is that Blumberg clearly would allow a document with embedded images [0101] to be modified, e.g. the view of the image shown to the user can be modified by the user, so if the user is not happy with view Figure 4A, the user can act to obtain another view as in Figure 4B and/or Figure 4C. Note these are merely exemplary.

If the electronic product of Roses and Noda used images hosted on a remote server rather than simply off the local hard drive, as in Roses, which would, examiner notes, provide substantial benefits as it would allow access to more files that the user could utilize and would further not require the files to be hosted on the local machine, such that if the template were a photo album page (Noda) that the images could be obtained from Ofoto® or another similar online photograph hosting service, as is at least suggested by Blumberg.

Noda further supports correcting the image quality even after the image is pasted into the template [0102] and supported in [0098]. This would suggest that the image, even after being cropped, could still be modified at least to some extent, which supports the idea of Blumberg. Namely, Blumberg teaches in [0013-0016] that the system is advantageous precisely because the client computer only downloads that portion of the image that is necessary (e.g. only the cropped or visible version). Further, by using the system of Blumberg in combination with Noda, the user could then easily choose the desired version of the image and manipulate it prior to cropping it.

Based on the above, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Noda and Roses with Blumberg, which would produce the recited system of applicant, and there is sufficient motivation as above, so such combination would not be improper hindsight, because obviously the scalable document is very useful in allowing the user to decide what portion of an image should be viewed in the document and view many different versions of the image according to their personal preference. Further, if Noda pulled the images for modification off the server then showed the crop boundaries, then only the selected regions would be shown in the output template document, which the user could manipulate and then change to whatever portion of the base image was desired, e.g. the crop indicator would obvious show – where cropping as defined in the instant application is not cropping per se, but rather showing the desired region of a base image, which Blumberg clearly allows the user to do, and clearly with Blumberg the user could alter that area within the viewing window, which is equivalent to displaying the cropping indicator to the user, and Noda would support that anyway as set forth above. Finally, the full resolution image on the server of Blumberg would be the base image of Noda, and thusly the base image recited in the above claim.

As to claims 3 and 13; as set forth in the rejection to claim 1, Noda allows the user to change the size, position, and other aspects of the cropping boundary, which is prima facie equivalent to the cropping indicator [0083-0084], clearly this is done relative to the base image, where the base image is shown on the screen and the cropping

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indicator is altered relative to the base image as desired by the user. Motivation and combination is taken from the parent claim and incorporated by reference herein.

As to claims 4 and 14, Noda clearly sets forth in [0082-0083] that the user cannot change the aspect ratio (e.g. the width to height ratio) even though the size can be in certain embodiments. Motivation and combination is taken from the parent claim and incorporated by reference herein.

As to claims 5 and 15, the system of Roses allows the user to view the image in the preview window 602 of Fig. 6 when the image has been selected and scaled and/or cropped to fit, or manually filtered – see Fig. 6 and [0043-0044], and so it is updated, and the user can also do so at any time by hitting the preview button. The Blumberg reference further updates the image shown in the document after the user has altered in [0093-0105]. Further, motivation or combination is taken from the rejection to the parent claim and herein incorporated by reference. Updating an image upon modification in the preview window is also prima facie obvious.

As to claims 6 and 16, the user can prima facie move the crop boundary / indicator around the base image in Noda as taught in [0081] and as shown in Fig. 3 for example. Motivation and combination is taken from the parent claim and incorporated by reference herein.

As to claims 7 and 17, the system of Roses allows the user to view the image in the preview window 602 of Fig. 6 when the image has been selected and scaled and/or cropped to fit, or manually filtered, or the cropping window has been repositioned or moved (see Noda [0081—0082]) – see Fig. 6 and [0043-0044], and so it is updated,

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and the user can also do so at any time by hitting the preview button. Updating an image upon modification in the preview window is also prima facie obvious. Motivation and combination is taken from the parent claim and incorporated by reference herein. Also see the discussion in the rejection to claim 5 above, which is incorporated by reference.

As to claims 21 and 26, the Noda reference very clearly teaches that the user can open a template and that the system can automatically insert an image that is scanned into the first field in the template, which clearly would constitute the recited limitation – e.g. the computer would automatically selected the base image associated with the selected image area – see [0051-0057], Noda. Motivation and combination is taken from the parent claim and incorporated by reference herein.

As to claims 22 and 27, the Noda reference very clearly teaches that the user can select a thumbnail of an image to put into a template [0051-0057], and clearly in Figure 7 the crop boundary takes the shape and size of the template, but can be altered by the user. In any case, the system of Noda can automatically select a portion of the image to crop and display in the template (e.g. centered crop [0051-10062]), which constitute the user not selecting the portion shown initially in the template as recited in the instant claim. Motivation and combination is taken from the parent claim and incorporated by reference herein.

As to claims 23 and 28, obviously Roses allows the user to manipulate the size of the template areas [0037], where their location is independent of each other. Further, Noda teaches that templates (e.g. Figures 10A-10D) may have overlapping images, so

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very clearly it would be obvious that the various images or portions of the template would be independent of each other since Roses allows the user to control all aspects of the template per se. Motivation and combination is taken from the parent claim and incorporated by reference herein.

As to claims 24 and 29, Noda clearly teaches that various templates can be shown to a user to allow the user to select the desired template [0080 specifically, [0078-0082 generally]], and Noda teaches selecting various images via thumbnail in [0055-0057] for example, where it would be obvious that if the user can select from amongst a plurality of visual templates, that thumb nailing the templates would be an obvious expedient to speed the selection process, since Noda does so for images explicitly and implicitly would do so since the plurality of templates would be visible to the user to select from, and this modification (if required) would have been obvious. Motivation and combination is taken from the parent claim and incorporated by reference herein.

As to claims 25 and 30, obviously the user is allowed to select the image that goes into a particular template area [0055-0057 for examples]. It would be obvious that the user could choose another image to put into the image area depending on their tastes and preferences, since the association between images and base areas is preserved and not made permanent until an output document is created, e.g. a photograph album page is printed, and the like. Noda and Roses both allow the user to change the desired image, and further the system of Blumberg will allow the user to specify an image by specifying the path of the image on the remote server, where

altering the displayed image would be merely a function of changing the image path. Motivation and combination is taken from the parent claim and incorporated by reference herein.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric V. Woods whose telephone number is 571-272-7775. The examiner can normally be reached on M-F 7:30-4:30 alternate Fridays off.

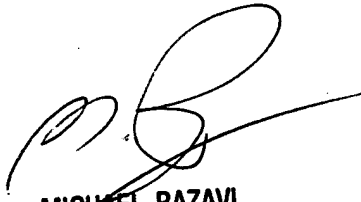
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Razavi can be reached on 571-272-7664. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Eric Woods

July 27, 2005



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